

REMARKS

The Present Invention

The present invention relates to a cosmetic composition for skin and hair which delivers a moisturizing effect, without a sticky sensation. The cosmetic non-sticky moisturizer for skin and hair includes

- (a) at least about 10% by weight of the composition of a polyhydric alcohol humectant;
- (b) about 0.01% to about 10% of a polymeric wetting agent which forms a uniform film in a Wetting Test;
- (c) a cosmetically acceptable vehicle.

The moisturizing capabilities of humectants, such as glycerol and sorbitol which may be generally known, are concentration dependent. Unfortunately, when incorporated into formulations at concentrations above 10%, they confer a sticky, tacky feeling. Due to this unpleasant consumer sensory experience formulations containing higher levels of humectants are, for the most part, not commercially acceptable. The present invention meets the need for commercially acceptable moisturizing compositions containing higher levels of humectants.

The polymeric wetting agent may be an amphipathic block copolymer, a polymer containing a hydrophilic backbone modified with hydrophobic groups, or mixtures thereof.

New Claims 8-13

New independent claim 8 has been added, reciting "consisting essentially of" language, thereby excluding non-essential components, such as those included with certain cited art which Applicants deem to be non-analogous. Support for claim 8 may be found in the Specification and in claim 1. Applicants respectfully submit that claim 8 and those dependent thereon, 9-13, are in condition for allowance.

Care has been taken not to introduce any new matter by way of the claim amendments and the new claims.

Specification

Although Applicants respectfully submit that the trademark need not be capitalized if the text uses the word "trademark" in the sentence to thereby designate the mark, the Specification has been amended to capitalize trademarks, including PEMULEN, CETIO, PARSOL, BENZOPHENONE-3. Where not already done, a generic term has been inserted to accompany the trademark.

Rejections under 35 USC § 102

Claims 1,3,5 and 7 were rejected under 35 USC 102(b) as being anticipated by Brewster et al. (US 5,128,123).

According to the Office Action, Brewster discloses a clear cosmetic stick composition comprising 10-90% of a polyhydric alcohol, 1-40% of a soap (salt of a fatty acid), and 1-40% of alkoxylate copolymer and an effective amount of clarifying agent,

which is an amine base (abstract, column 2, lines 25-46 and column 3, lines 3-15). The basic amine is present in amounts ranging from about 0.1% to about 20%, the soap is present in amounts from about 1% to about 40% and are formed from fatty acids of myristic, palmitic, stearic, oleic, linoleic, linolinic, margaric and mixtures of these acids, the polyhydric acids are selected from ethylene glycol, propylene glycol, trimethylene glycol, glycerin and sorbitol (column 4, lines 6-56); The composition may contain one or more of the following specific emollients: isopropyl palmitate, cetyl alcohol, stearyl alcohol, diisopropyl adipate, dimethicone copolyol, cyclomethicone, dimethicone and alkyl polyglycosides; and the emollients may be present in amounts ranging from about 1% to 40% (column 6 lines 1-8).

Further, according to the Office Action, Brewster specifically teaches cosmetic stick comprising propylene glycol that is a polyhydric alcohol, deionized water, sodium stearate, alkoxylated copolymer, irgasan DP-300, amine base and red color (Table 1). The weight percent of the polyhydric alcohol, propylene glycol is 61.50% for formulation A, 60.00 for formulations B and C, and 62.00 for formulation D (Table 1). The alkoxylated copolymer is a poly(ethylene oxide)(propylene oxide)(ethylene oxide) copolymer and is included in formulations A-D (Table) in 4 weight percent.

According to the Office Action, the teachings of Brewster read on the scope of the claims and a composition that reads on the composition of generic claim 1 would inherently be non-sticky. Applicants respectfully traverse the rejection.

To establish that a particular element is inherently disclosed by a reference, the Office Action must establish that the descriptive matter missing from the reference is necessarily present in the reference's disclosure, and that persons of ordinary skill in

the art would recognize the presence of that element. Continental Can Company, U.S.A. v. Monsanto Company, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991).

There can be no anticipation because the Wetting Test element is not disclosed in Brewster et al. There is not anticipation here because Brewster et al do not disclose a polymeric wetting agent that forms a uniform film in a Wetting Test. There can be no inherency unless it can be shown that the disclosure of Brewster et al. will always and necessarily employ a polymeric wetting agent that forms a film in a Wetting Test and will always and necessarily employ a combination of other ingredients such as to form a non-sticky moisturizer. The data in Tables A and B at page 5 of the specification show that not all polymers form a uniform film in a Wetting Test. For example, while Pemulen TR2 forms a uniform film, Carbopol 981 does not. Example 1 on pages 11-12 of the specification also demonstrate the non-inherency of the uniform film characteristic, in Table 1 and comparative Table 2.

In sum, inherency may not be established by probabilities or possibilities. Continental Can Company, U.S.A. v. Monsanto Company, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Since Brewster et al. Fails to disclose either explicitly or inherently a polymeric wetting agent which forms a uniform film in a Wetting Test, a person skilled in the art would not find that Brewster et al inherently disclose a non-sticky composition.

Rejections under 35 USC § 103

Claim 4 was rejected under 35 USC 103(a) as being unpatentable over Brewster et al. (US 5,128,123). According to the Office Action, Brewster teaches the composition of the instant invention except that Brewster's examples do not contain volatile silicone

oil. However, according to the Office Action, Brewster suggests incorporating isopropyl palmitate emollients as optional agents in the cosmetic stick and isopropyl palmitate is an oil. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optionally incorporate isopropyl palmitate emollients as suggested by Brewster with the expectation that the emollient would make the cosmetic stick less harsh to the skin and would soften and soothe the skin.

Applicants respectfully traverse this rejection. Applicants respectfully submit that disclosure of isopropyl palmitate emollients is not a suggestion of volatile silicone oils. Moreover, as claim 1 is novel and unobvious over Brewster et al., its dependent claim 4 is likewise novel and not obvious.

Claim 6 was rejected under 35 USC 103(a) as being unpatentable over Brewster et al. (US 5,1128,123). According to the Office Action, Brewster teaches the composition of the instant invention except that Brewster's examples do not contain an oil. However, Brewster suggests incorporating cyclomethicone or dimethicone emollients as optional agents in the cosmetic stick. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to optionally incorporate the cyclomethicone or dimethicone emollients as suggested by Brewster with the expectation that those emollients would make the cosmetic stick less harsh to the skin and would soften and soothe the skin.

Applicants respectfully traverse and submit that Claim 6 is non-obvious because claim 1 from which it depends is new and non-obvious.

Claims 1-7 were rejected under 35 USC 103(a) as being unpatentable over Beerse et al. (US 6,294,186). According to the Office Action, Beerse discloses an antimicrobial composition, which can be applied to the skin, containing water or alcohol solution as a carrier (column 9, lines 32 and 34). The composition comprises hydrophilic gelling agents amongst which is listed PEMULEN TR-1 and oleogels; the composition may also contain from about 0.1% to about 20% lipophilic skin moisturizing agents/emollients such as polymethyl siloxanes, methylphenylpolysiloxanes, dimethicones, cyclomethicones, alkyl siloxanes and oils (column 10, line 7 to column 11, line 16); Dimethicone copolyol emulsifiers are useful in Beerse (column 15, line 36 to column 16, line 59). Beerse's composition may also contain conditioning agents selected from humectants, moisturizers or skin conditioners in an amount from about 0.1% to about 20%, and examples of moisturizing agents are polyhydroxy alcohols such as sorbitol, glycerol, hexanetriol, propylene glycol (column 36, lines 14-35). Beerse et al provide an example of thickening agents that can be contained in the composition and specific examples of PEMULEN TR-2 and PEMULEN TR-1 are listed (column 36, line 54 to column 38, line 23). Beerse's composition optionally contains detackifying agents that reduce stickiness or tack associated with humectants and/or gelling agents (column 38, lines 33-43). Beerse also discloses that silicone elastomers are also useful as detackifying agents and cyclomethicone and dimethicone crosspolymer blend is listed as example of the silicone elastomer (column 40, lines 33-63).

The Office Action cites Examples 16-18 as teaching hand compositions that contain 20% glycerin, 8% dipropylene glycol, 22.8-28.09% water, 4% isopropyl palmitate, 9.1-13% cyclomethicone, 11-14.55% cyclomethicone/dimethicone copolyol, salicylic acid, fragrance and synthetic wax; Examples 14 and 15 as containing

PEMULEN TR-1 and CARBOPOL in addition to glycerin, butylene glucol, cyclomethicone and dimethicone copolyol, cyclomethicone and dimethicone, dimethicone copolyol, salicylic acid and water.

The Office Action alleges that the generic claim of the instant composition is directed broadly to polyhydric alcohol, polymeric wetting agent and cosmetically acceptable vehicle except for specifying amount of the humectant and a range of amount of the polymeric wetting agent; In examples 14-15, Beerse teaches the composition of the instant invention except that the amount of the polyhydric alcohol is 3.08, which is the sum of the amount of glycerin and butylene glycol. This amount of polyhydric alcohol differs from the recited amount of at least 10% and about 10% to about 90%. At the same time, in examples 16-18, Beerse teaches compositions that can be applied to the hands to provide antibacterial effect in the same way as the compositions in examples 14 and 15 provide for antibacterial effect. The compositions in examples 16-18 contain 28% of polyhydric alcohol, which is the sum of the amounts of glycerin and dipropylene glycol. There is thus, according to the Office Action, a suggestion in Beerse that a hand antibacterial composition could contain polyhydric alcohol in amounts of about 20-28%.

Therefore, according to the Office Action, it would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the amount of polyhydric alcohol in the hand composition in examples 14 and 15 of Beerse from 3.08 to about 20-28%, since Beerse in examples 16-18 teaches hand composition that contains 20-28% polyhydric alcohol.

Applicants respectfully traverse. Beerse et al. do not disclose or suggest a composition that has all the elements of claim 1, i.e. (a) high enough concentration of polyhydric alcohol, (b) 0.01 – 10 % of a polymeric wetting agent that forms a uniform film, and (c) vehicle. Beerse et al may disclose Pemulen TR1 and Pemulen TR2, however, the data in the present Specification show that Pemulen TR-2 but not Pemulen TR-1 meets the Wetting Test. Carbopol 981 disclosed in Beerse et al likewise does not meet the Wetting test. The unique combination of components in the claimed amounts according to the present invention yields an unexpectedly moisturizing but non-sticky composition.

An obviousness rejection is proper only when “the subject matter as a whole would have been obvious at the time the invention was made ...” (emphasis added). 35 U.S.C. 103. Applicants respectfully submit that the Office Action has improperly picked and chosen certain aspects of the reference, without showing where the motivation is to combine them to come up with the subject matter of the present invention as a whole, within the meaning of 35 U.S.C. 103.

The Court of Appeal for the Federal Circuit has repeatedly held that when making out a *prima facie* case of obviousness, the focus must be on the invention as a whole,

That features, even distinguishing features are “disclosed” in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. 35 U.S.C. 103.

Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1549, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Applicants have shown that the teachings of the cited reference in its entirety would not lead one of ordinary skill in the art to combine the teachings to produce the claimed invention. The cited reference concerns other aspects which are not related to the composition elements as claimed.

Applicants respectfully assert that the claims are not anticipated by Brewster et al. Applicants submit that the pending claims are not obvious over the cited references, under 35 U.S.C. 103. Reconsideration and withdrawal of the rejection is respectfully requested.

Certainly, new claims 8 – 13 are novel and not obvious, as they are directed to a specific unique combination of components that make up the non-sticky moisturizer of the present invention.

Attached hereto is a marked-up version of the changes made to the Specification by the current amendment. The attached page is captioned **"Version With Markings to Show Changes Made."**

Respectfully submitted,



Ellen Plotkin
Registration No. 36,636
Attorney for Applicant(s)

(201) 840-2253

Version With Markings to Show Changes Made

In the Specification:

The Specification at page 4, lines 18 and 19 has been amended as follows:

A glycerol wetting agent meets criterium (a) only. For example, ~~Pemulen~~
PEMULEN TR-2 amphiphatic block copolymer meets (a), ~~Pemulen~~ PEMULEN TR-1
falls under (c), and ~~Carbopol~~ CARBOPOL 981 is (b).

The Specification at page 5, lines 15-25 has been amended as follows:

Table A

Polymers that formed a uniform film in a Wetting Test

Source	Polymer Trade Name	Polymer Conc. (%wt)	Glycerol Conc. (%wt)
BASF	Pluronic <u>PLURONIC F38</u>	0.25	99.75
BASF	Pluronic <u>PLURONIC F68</u>	0.25	99.75
BF Goodrich	Pemulen <u>PEMULEN TR2</u>	0.25	99.75
BF Goodrich	Pemulen <u>PEMULEN TR2</u>	0.25	30

Table B

Polymers that did not form a uniform film in a Wetting Test

Source	Polymer Trade Name	Polymer Conc. (%wt)	Glycerol Conc. (%wt)
BASF	Pluronic <u>PLURONIC L101</u>	0.25	99.75
BASF	Pluronic <u>PLURONIC L121</u>	0.25	99.75
BF Goodrich	Pemulen <u>PEMULEN TR1</u>	0.25	99.75
BF Goodrich	Carbopol <u>CARBOPOL 981</u>	0.25	99.75
Methylcellulose	Beneceel <u>BENECEL</u>	0.25	99.75
Hydroxyethylcellulose	Natrosol <u>NATROSOL</u>	0.25	99.75
Hydroxypropylcellulose	Klucel <u>KLUCEL</u>	0.25	99.75

The Specification at page 6, lines 18-24 has been amended as follows:

The wetting agent is included in the inventive compositions in the concentration of from 0.01% to 10%, preferably to optimize ratios of wetting agent and glycerol content for uniform spreading and non-sticky feel, from 0.01% to 2%, most preferably in order to deliver non-sticky feel without being too viscous, from 0.1% to 2%. The most preferred wetting agents are ~~is Pemulen~~ PEMULEN TR-2 and ~~Pluronic~~ PLURONIC F38, because they are cosmetically acceptable raw materials, sufficiently hydrophobic to stick to skin.

The Specification at page 7, lines 18-24 has been amended as follows:

Suitable fluid oils include but are not limited to esters of fatty acids or alcohols and hydrocarbons, preferably monoesters of fatty acids or alcohols, as long as they satisfy the solubility requirements described herein. Most preferably, fluid oil is selected from the group consisting of isostearyl palmitate, tridecyl salicylate, C12-15 octanoate, isopropyl stearate, isopropyl myristate and isopropyl palmitate, or any mixtures thereof. Dicapryl ether, such as with a trade name, ~~Cetio~~ CETIO OE, is also included as most preferable oil.

The Specification at page 8, lines 20-25 has been amended as follows:

Sunscreens include those materials commonly employed to block ultraviolet light. Illustrative compounds are the derivatives of PABA, cinnamate and salicylate. For example, octyl methoxycinnamate and 2-hydroxy-4-methoxy benzophenone (also known as oxybenzone) can be used. Octyl methoxycinnamate and 2-hydroxy-4-methoxy benzophenone are commercially available under the trademarks, ~~Parsol~~ PARSOL MCX and ~~Benzophenone~~ BENZOPHENONE-3, respectively.

In the Claims:

New claims 8, 9, 10, 11, 12 and 13 have been added as follows:

8. (New) A cosmetic non-sticky moisturizer for skin and hair consisting essentially of:

- (d) about 10% to about 90% by weight of the composition of a polyhydric alcohol humectant;
- (e) about 0.01% to about 10% of a polymeric wetting agent which forms a uniform film in a Wetting Test;
- (f) a cosmetically acceptable vehicle.

9. (New) The composition of claim 8, wherein the composition further comprises an elastomer.

10. (New) The composition of claim 8, wherein the composition further comprises a volatile silicone oil.

11. (New) The composition of claim 8, wherein the composition further comprises a fluid oil.

12. (New) The composition of claim 8, wherein the composition further comprises a crystalline fatty acid.

13. (New) The composition of claim 8, wherein the polymeric wetting agent is selected from the group consisting of:

- (b1) an amphipathic block copolymer;
- (b2) a polymer containing a hydrophilic backbone modified with hydrophobic groups; and
- (b3) mixtures thereof.